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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,845

05/17/2006

Walter Rosenbaum

2004P19118

5727

24131 7590 07/29/2009
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EXAMINER

CHEN, GEORGE YUNG CHIEH

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

07/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,845	Applicant(s) ROSENBAUM, WALTER	
	Examiner George Chen	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/29/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3628

1. DETAILED ACTION

2. This communication is a non-final action in response to RCE filed on 06/04/2009. Claims 1-5, 7-11 are pending with claims 1 and 7 amended and claims 6, and 12 cancelled.

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/04/2009 has been entered.

4. Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 06/29/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

6. Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart (US 20050192913 A1) in view of Goodman (US 5146403).**

9. As per claim 1, Lubart discloses a method of forwarding post, comprising the steps of:

- ✓ providing a post forwarding apparatus for scanning an address face of the post for a TAG ID and consulting a database for records related to the

Art Unit: 3628

TAG ID, the records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. and see at least 0022, each profile and one or more sub profile comprise a valid date range defining when the profile and one or more sub profiles are active and therefore a user can set a date range for a mail service. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

- ✓ if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

Goodman teaches:

- ✓ if the destination address is expired, automatically determining if an addressee of the post maintains a forwarding service account (see at least

Art Unit: 3628

Goodman, column 2, line 36-48, a service computer receives the change of address information from all of the terminals), and

One of ordinary skill in the art would have recognized that applying the known technique of Goodman to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Goodman to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying if the destination address is expired, automatically determining if an addressee of the post maintains a forwarding service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow lower error rate (see at least Goodman, column 2, line 15-20).

10. As per claim 7, Lubart discloses an apparatus for forwarding post, comprising:

- ✓ means for scanning an address face of the post for a TAG ID and consulting a database for records related to the TAG ID, the records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. and see at least 0022, each profile and one or more sub profile comprise a valid date range defining when the profile and one or more sub profiles are active and therefore a user can set a date range for a mail service. And see at least 0078, if a mail

Art Unit: 3628

object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

- ✓ means for automatically debiting said account in an appropriate amount and forwarding the post to an addressee destination address if said forwarding service account is maintained (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

Goodman teaches:

- ✓ means for automatically determining if an addressee of the post maintains a forwarding service account if said address is expired (see at least Goodman, column 2, line 36-48, a service computer receives the change of address information from all of the terminals), and

One of ordinary skill in the art would have recognized that applying the known technique of Goodman to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Goodman to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying if the destination address is expired, automatically determining if an addressee of the post maintains a forwarding service account to Lubart would have been recognized by one of

Art Unit: 3628

ordinary skill in the art as resulting in an improved system that would allow lower error rate (see at least Goodman, column 2, line 15-20).

11. Claims 2-3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart in view of Goodman, further in view of Nielsen.

12. As per claim 2, Lubart discloses the method according to claim 1, but does not explicitly disclose further comprising the step of automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated

Art Unit: 3628

by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient process (see at least Nielson, column 1, line 33-47)

13. As per claim 3, Lubart further discloses the method according to claim 2, further comprising the step of not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account (see at least Lubart, 0022, a user can set a date range for a mail service and after expiry of the date range the mail service will revert back to a predate range profile).

14. As per claim 8, Lubart discloses the apparatus according to claim 1, but does not explicitly disclose further comprising means for automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding

Art Unit: 3628

service account to said addressee if said addressee does not maintain a forwarding service account.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient process (see at least Nielson, column 1, line 33-47)

15. As per claim 9, Lubart further discloses the apparatus according to claim 2, further comprising means for not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account (see at least Lubart, 0022, a user can set a date range for a mail service and after expiry of the date range the mail service will revert back to a predate range profile).

16. Claims 4, 5, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart in view of Goodman, further in view of Nielsen, even further in view of Kuebert et al. (hereinafter Kuebert, US 20020165729 A1).

Art Unit: 3628

17. As per claim 4, Lubart discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying the post. Kuebert teaches step of not forwarding further comprises the step of destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

One of ordinary skill in the art would have recognized that applying the known technique of Kuebert to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Kuebert to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying the step of destroying the post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would be cheaper (Kuebert, 0055).

18. As per claim 5, Lubart discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a pre-selected time delay prior to destruction of said post. Goodman, however, discloses having a pre-selected time delay prior to next action to ensure user having enough time to make decision (see at least Fig. 10, step 1003, has timer elapsed).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from having a pre-selected time delay prior to next action to ensure user having enough time to make decision to a pre-selected time delay prior to destruction of said post.

Art Unit: 3628

One of ordinary skill in the art would have recognized that applying the known technique of Goodman to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Goodman to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having enough time to make decision to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow lower error rate (see at least Goodman, column 2, line 15-20).

19. As per claim 10, Lubart discloses the apparatus according to claim 9, but does not explicitly disclose wherein said means for not forwarding further comprises means for destroying the post. Kuebert teaches means for not forwarding further comprises the means for destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

One of ordinary skill in the art would have recognized that applying the known technique of Kuebert to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Kuebert to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying the step of destroying the post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would be cheaper (Kuebert, 0055).

20. As per claim 11, Lubart discloses the apparatus according to claim 10, but does not explicitly disclose wherein said means for not forwarding further comprises a pre-selected time delay prior to destruction of the post. Goodman, however, discloses having a pre-selected time delay prior to next action to ensure user having enough time to make decision (see at least Fig. 10, step 1003, has timer elapsed).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from having a pre-selected time delay prior to next action to ensure user having enough time to make decision to a pre-selected time delay prior to destruction of said post.

One of ordinary skill in the art would have recognized that applying the known technique of Goodman to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Goodman to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having enough time to make decision to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow lower error rate (see at least Goodman, column 2, line 15-20).

21. *Response to Argument*

22. Regarding Applicant's argument per section Remarks/Argument,

Art Unit: 3628

23. Applicant's arguments with respect to claims 1-5, 7-11 have been considered but are moot in view of the new ground(s) of rejection.

24. Applicant's arguments are moot in view of the new prior art Lubart

25. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Chen whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G.C./

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628